

## **REMARKS**

### **Pending Claims**

Claims 1, 2, 4, 6, 8-16, 18, and 22-26 have been examined. Claims 24-26 have been withdrawn from consideration. Claims 1, 2, 4, 6, 8-16, 18, 22, and 23 have been rejected.

Claim 1 has been amended to include all of the elements of non-rejected claim 11. Claims 10 and 11 have been canceled. Claim 1 has also been amended to obviate the indefinite rejection by deleting the terms: "an ester" and "a compound of the formula (I) in .... is optionally protected." Claim 9 has been amended to depend from claim 1. Claims 12, 13, 14, and 16 have been each rewritten in independent form to include all the elements of claim 1. Claim 18 was rewritten in independent form. Therefore, pending claims are 1, 2, 4, 6, 8, 9, 12-16, 18, 22 and 23. No new matter has been added in any of the claims.

### **Claim Rejections - 35 USC §103**

Claims 1, 2, 4, 6, 8-10, 15, 22, and 23 have been rejected under 35 USC §103(a) as being unpatentable over Nishimura (Journal of Antibiotics, Vol. 45, 1992, p. 485-499), USP 4788185, WO 97/41128, and USP 4427677.

Claims 1, 2, 4, 6, 8-10, 15, 22, and 23 have been rejected under 35 USC §103(a) as being unpatentable over USP 4788185.

Claims 1, 2, 4, 6, 8-10, 15, 22, and 23 have been rejected under 35 USC §103(a) as being unpatentable over USP 4427677.

Applicants traverse the above rejections in view of the amendments to claim 1. Claim 1 has been amended to incorporate all of the elements of claim 11, which has not

been rejected under 35 USC §103(a). Therefore, by incorporating claim 11 into claim 1, claim 1 is believed to have been rendered non-obvious over the cited references.

Withdrawal of the rejections against claim 1 is respectfully requested.

Because claims 2, 4, 6, 8, 9, 15, 22, and 23 all depend from claim 1, these claims have also been rendered non-obvious over the cited prior art references for at least the same reasons as claim 1.

Claims 12, 13, 14, 16, and 18 have been each rewritten in independent form. Because those claims have not been rejected under §103(a), they are believed to be non-obvious and allowable over the prior art references cited above.

#### **Claim Rejections - 35 USC §112**

a) Claims 1, 2, 4, 6, 8-16, 18, 22, and 23 have been rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly, the Examiner has rejected the claims for being unclear as to 1) what is being protected in the aminothiazole, 2) what Z embraces, 3) what the scope of "group" is, and 4) which claim claim 9 depends from.

With regard to points 1) and 3) in the Office Action, claim 1 has been amended to delete the terms "an ester" and "a compound of the formula (I) in which the amino group on the thiazole at the 7-position is optionally protected." Furthermore, Z, a heterocyclic group, has been clearly claimed by incorporating claim 11. Therefore, any objections or rejections of claim 1 with regard to points 1) and 3) have been obviated. Additionally, independent claims 12-14, 16, and 18 are also not indefinite with regard to points 1) and

3) because those claims do not have the terms: "an ester" and "a compound of the formula (I) in which the amino group on the thiazole at the 7-position is optionally protected." The claims also clearly claim what Z is. Furthermore, dependent claims 2, 4, 6, 8, 9, 15, 22, and 23 are also not indefinite for at least the same reasons as their base claim. Claims 10 and 11 have been canceled.

With regard to point 2) in the Office Action, claim 1 has been amended to incorporate claim 11 to clarify what Z embraces. Independent claims 12-14, 16, and 18 have the same or similar language as amended claim 1, and therefore, what Z embraces is also clear in those claims. The dependent claims are not indefinite for at least the same reasons as their base claim.

With regard to point 4), claim 9 has been amended to depend from claim 1.

b) Claims 1-9, 15, 19, 20, 22, and 23 have been rejected under 35 USC §112, first paragraph, as failing to comply with the enablement requirement. The Examiner states that because of points 2) and 3), the cited claims are non-enabled. However, claim 1 has been amended to obviate points 2 and 3 as previously described. Independent claims 12-14, 16, and 18 are also enabled for at least the same reasons as claim 1. Therefore, for at least the same reasons as described in part a), the cited claims are enabled.

Also, note that claims 3, 5, 7, 19 and 20 have been previously canceled, and therefore, rejections against those claims are believed to be moot.

Applicants respectfully submit that for the foregoing reasons, the indefinite and non-enablement rejections have been obviated for all of the pending claims.

### **Summary**

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 2, 4, 6, 8-10, 12-16, 18 and 22-26 in condition for allowance. Applicant submits that the proposed amendments of claims 1 and 9 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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